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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SANG-HYUN SHIN

Appeal 2009-000739
Application 09/774,008¹
Technology Center 2400

Decided: September 9, 2009

Before LANCE LEONARD BARRY, JAY P. LUCAS, and JOHN A. JEFFERY, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals from a final rejection of claims 1 to 9, 12 and 15 to 18 under authority of 35 U.S.C. § 134(a). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

¹ Application filed January 31, 2001. Appellant claims the benefit under 35 U.S.C. § 119 of application 00-30584, filed 06/03/2000 in the Republic of Korea. The real party in interest is Samsung Electronics Co., Ltd.

Appellant's invention relates to a method of communicating between mobile telephones using Internet protocol. In the words of Appellant:

A communication system which allows IP-based communication regardless of whether an Internet protocol (IP) connection exists in a mobile telephone network, and a method thereof are provided. The method includes the steps of receiving a request for an IP address of the other terminal, the request being made using a telephone number, checking whether or not an IP address corresponding to the telephone number is registered upon receipt of the request, and assigning an IP address of the other terminal corresponding to information from an IP address server, if the IP address is not registered. Thus, in a mobile telephone network using a telephone number, a terminal can carry out IP-based video and audio communications with the other terminal via a name server or network, regardless of an IP connection of the other terminal.

(Spec. 14, ll. 2-14).

Claim 1 and claim 8 are exemplary:

1. A method of performing an Internet protocol (IP)-based communication between wireless terminals, the method comprising the steps of:
 - (a) receiving a request for an IP address of a second terminal from a first terminal;
 - (b) upon receipt of the request, checking whether an IP address corresponding to the second terminal is registered; and
 - (c) if the IP address is not registered, assigning an IP address to the second terminal corresponding to information from an IP address server,
wherein the first terminal is a first wireless terminal and the second terminal is a second wireless terminal.

8. A name server in an internet protocol (IP)-based communication system comprising:

a communication module unit for sending and receiving IP-based data;

a controller for registering telephone numbers and requests for translation of wireless telephone numbers into IP addresses; and

a database for storing IP addresses and wireless telephone numbers as determined by the controller,

wherein the communication module unit sends and receives IP-based data to and from external devices and the external devices include IP address servers.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Mendiola	US 2002/0006803 A1	Jan. 17, 2002
		(filed on May 2, 2001)

REJECTION

The Examiner rejects the claims as follows:

R1: Claims 1-9, 12, and 15-18 stand rejected under 35 U.S.C. § 102(e) for being anticipated by Mendiola.

Groups of Claims:

Claims will be discussed in the order of the arguments. *See* 37 C.F.R. § 41.37(c)(vii).

Appellant contends that the claimed subject matter is not anticipated by Mendiola for failure of the reference to teach the claimed limitations. The Examiner contends that each of the claims is properly rejected.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellant have been considered in this opinion. Arguments that Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived.

We affirm-in-part.

ISSUE

The issue is whether Appellant has shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 102(e). The issue turns on whether Mendiola teaches checking whether an IP address of a called wireless terminal has a registered IP address, and registering it if it does not.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellant has invented a method and system for communicating by mobile telephones using Internet IP addresses (Spec. 1, l. 5). A request is made from a first phone providing the telephone number of the second (called) phone (Spec. 3, l. 15). A Name Server assigns an IP address to the called phone, registering that IP address to the given telephone number in a database and communicating the IP address to the first phone (Spec. 6, l. 10). Before assigning the new IP address to the called phone,

the Name Server checks if the called phone already has an IP address (Spec. 6, l. 7).

2. Mendiola teaches a method and system for registering new users of an Internet instant messaging (IM) service (¶¶ [0043], [0044]). On being referred to the service by a first wireless caller, by either mobile phone or e-mail, the system assigns a tentative unique identification number (UIN) to the called phone or recipient e-mail user (¶¶ [0072], [0073], and [0089]). In a confirmation step, the registration handler can render the tentative UIN permanent (¶¶ [0048], [0102] *et seq.*).

PRINCIPLES OF LAW

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

"In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted).

"This court has held in a number of decisions that a United States patent speaks for all it discloses as of its filing date, even when used in combination with other references." *In re Zenitz*, 333 F.2d 924, 925 (CCPA, 1964) (internal citations omitted).

Our reviewing court states in *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989), that “claims must be interpreted as broadly as their terms reasonably allow.” Our reviewing court further states that “the words of a claim ‘are generally given their ordinary and customary meaning.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). The “ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” *Id.* at 1313.

ANALYSIS

From our review of the administrative record, we find that the Examiner has presented a prima facie case for the rejections of Appellant’s claims under 35 U.S.C. § 102(e). The prima facie case is presented on pages 3 to 14 of the Examiner’s Answer. In opposition, Appellant presents a number of arguments.

We note that dependent claims will stand or fall with their respective independent claims.

Arguments with respect to the rejection of independent claim 1 under 35 U.S.C. § 102(e) [R1]

Appellant presents a number of arguments against the Examiner’s finding of anticipation (App. Br. 10, 11). Appellant first contends that Mendiola does not teach an Internet Protocol (IP) address, as claimed (App. Br. 10, middle). As terms during examination are interpreted broadly, but

fairly, we can agree with the Examiner's arguments that the UIN of the reference is not a telephone number but is a unique identifier designed to access, inter alia, PC-based clients (Ans. 16, middle). No specifics of the Internet protocols are mentioned in the claims, they are merely argued in Appellant's brief (Reply Br. 5, middle). We thus do not see error in the Examiner's rejection on this issue.

However, Appellant's second argument is dispositive of this appeal. Appellant contends that the Examiner erred in rejecting claim 1 as "Mendiola fails to disclose or suggest a method wherein (b) upon receipt of the request, checking whether an IP address corresponding to the second terminal is registered; and (c) if the IP address is not registered, assigning an IP address to the second terminal" (App. Br. 10, bottom).

The Examiner, in response, refers to Mendiola's assignment of tentative accounts for prospective users, and their subsequently being made permanent (Ans. 20, middle). We have carefully considered this argument and have read Mendiola completely. In that reference, there are numerous embodiments in which a UIN is generated and assigned (*e.g.*, ¶¶ [0072], [0089], [0094], [0101], *etc.*). In each and every one of them, the reference fails to teach or suggest that a check is performed to see if an IP address (*i.e.*, UIN) has already been registered to the submitted telephone number or user. Anticipation requires such a teaching of a claimed limitation; therefore, we agree with Appellant that the reference is defective without it.

*Arguments with respect to the rejection
of claims 7 and 8
under 35 U.S.C. § 102(e) [R1]*

Appellant only states that independent claims 7 and 8 are patentable for reasons similar to those submitted concerning claim 1 (App. Br. 11, bottom). Since the limitation described above concerning the conditional assignment of an IP address is present in claim 7, we agree that the rejection of that claim is also in error.

Claim 8, however, does not contain that limitation. The rejection of claim 8 is therefore not shown to be in error.

CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner erred in rejecting independent claims 1 and 7 and the claims dependent on them. We do not find error in the rejection of claim 8 and the claims dependent on it.

DECISION

The Examiner's rejection [R1] of claims 1 to 7 and 15 to 18 is reversed. The rejection of claims 8, 9, and 12 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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